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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEYHAN KARAOGUZ and JAMES BENNETT

Appeal 2009-006520
Application 10/675,903
Technology Center 2400

Before KENNETH W. HAIRSTON, MAHSHID D. SAADAT,
and ROBERT E. NAPPI, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304 or for filing a request for rehearing as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1-31, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' invention relates to controlling a transfer of media content in a communication network. At least one media file to be transferred via a communication channel in the communication network is specified. Various quality of service (QoS) parameters to be utilized for transferring one or more of the media files may also be specified. In one example, specified QoS parameters are transferred to a first communication device that is coupled to the communication network. A second device utilizes the transferred QoS parameters to configure the communication channel. The first communication device may be a broadband headend or a media server. The received input specifying one or more media files to be transferred may be generated and selected from a media guide, channel guide or a device guide such as may be displayed on a television screen within a home. (Spec. ¶¶ [09]-[10]).

Claim 1, which is illustrative of the invention, reads as follows (letter designations have been added to the steps, *i.e.*, paragraphs, of the claim for convenience in referencing *infra*):

1. A method, for controlling transfer of media content in a communication network, the method comprising:
 - [a] receiving an input specifying at least one media file for transfer via a communication channel in the communication network;

[b] causing a display of a plurality of quality of service options corresponding to said at least one media file for selection by a remote user;

[c] receiving a quality of service selection specifying at least one of said plurality of quality of service options; and

[d] transferring said at least one media file via said communication channel utilizing said quality of service selection.

The Examiner relies on the following prior art in rejecting the claims:

Nakatsuyama	US 6,253,246 B1	Jun. 26, 2001
Radford	US 2002/0144276 A1	Oct. 3, 2002

Claims 1-5, 7-15, 17-25, and 27-31 stand rejected under 35 U.S.C.

§ 102(b) as anticipated by Nakatsuyama.

Claims 1-7, 10-17, 20-27, 30, and 31 stand rejected under 35 U.S.C.

§ 102(a) as anticipated by Radford.

Claims 6, 16, and 26 stand rejected under 35 U.S.C. § 103(a) as obvious over Nakatsuyama.

Claims 8, 9, 18, 19, 28, and 29 stand rejected under 35 U.S.C.

§ 103(a) as obvious over Radford in view of Nakatsuyama.

Rather than repeat the arguments here, we make reference to the Briefs (Appeal Brief filed Jan. 22, 2008 and Reply Brief filed Jun. 16, 2008) and the Answer (mailed Apr. 15, 2008) for the respective positions of Appellants and the Examiner. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE(S)

Claims 1, 11, and 21 are independent claims. Claims 2-10, 12-20 and 22-31 depend, directly or indirectly, from claims 1, 11, and 21 respectively. Appellants have argued for the patentability of claim 1 over Nakatsuyama and over Radford, and have made no separate substantive arguments for the patentability of claims 2-31, relying solely on the arguments made for claim 1. Therefore, we select claim 1 as the representative claim, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii).

In arguing for the patentability of claim 1 Appellants contend that claim 1 is limited to performing step [b] (*see* convenience references added *supra*) *after* step [a] (App. Br. 9, 11; Reply Br. 4), but *before* step [d] (App. Br. 12-13; Reply Br. 7). Appellants further contend that claim 1 is limited to performing step [d] after steps [b] and [c]. (App. Br, 15). Although couched in terms of limitations of the claim Appellants contend are not disclosed by the references cited by the Examiner, Appellants arguments for the absence of those limitations of the claim from the disclosures of the cited references turn on whether claim 1 includes the sequence limitations argued by Appellants. The pivotal issue, therefore, is:

Whether claim 1 is limited to a process in which step [b] is performed after step [a] but before step [d] and in which step [d] is performed after steps [b] and [c].

PRINCIPLES OF LAW

[The USPTO] applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of

definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

In re Morris, 127 F.3d 1048, 1054 (Fed. Cir. 1997)

“Unless the steps of a method actually recite an order, the steps are not ordinarily construed to require one. However, such a result can ensue when the method steps implicitly require that they be performed in the order written.” *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1342-43 (Fed.Cir.2001) (citations omitted).

Interactive Gift recites a two-part test for determining if the steps of a method claim that do not otherwise recite an order, must nonetheless be performed in the order in which they are written. First, we look to the claim language to determine if, as a matter of logic or grammar, they must be performed in the order written. If not, we next look to the rest of the specification to determine whether it “directly or implicitly requires such a narrow construction.”

Altiris, Inc. v. Symantec Corp., 318 F.3d 1363, 1370 (Fed. Cir. 2003) (citing *Interactive Gift* at 1343).

ANALYSIS

Appellants contend that step [b] of claim 1 which recites “causing a display of a plurality of quality of service options *corresponding to said at least one media file* for selection by a remote user” (emphasis added) requires that the display of the quality of service options occur after step [a], which recites “receiving an input specifying *at least one media file* for transfer via a communication channel in the communication network” (emphasis added). (App. Br. 9, Reply Br. 4-5.) The Examiner responds that the claim does not preclude the media file input selection and the quality of

service option display from occurring at the same time. (Ans. 11-13.) Appellants further contend that steps [b] and [c] must occur before step [d] (App. Br. 11-12, 15; Reply Br. 7). The Examiner responds that the claim does not preclude the streamed data content and the video quality control from being displayed and adjusted at the same time. (Ans. 16-18.)

From the context in which Appellants use the words “before” and “after” in the arguments, the overall thrust of Appellants’ arguments is that claim 1 requires that step [a] be performed first, before any of the other steps are initiated. Then, only after step [a] is complete, steps [b] and [c] are performed before step [d] is initiated. Finally, after steps [b] and [c] are complete, step [d] is initiated. The Examiner’s position is that nothing in the claim precludes simultaneous, overlapping and/or out of sequence execution of the argued steps of claim 1. We agree with the Examiner.

Despite Appellants’ multiple references to steps of claim 1 being “before” or “after” other steps (App. Br. 9, 11-21; Reply Br. 4,7), we do not find those words in the claim. In fact, we find no express statement of a sequence of steps in the claim. *See Interactive* at 1342-43.

Appellants’ position with regard to the relationship between the step [b] and the step [a] rests on the word “corresponding” in step [b], together with the fact that the phrase “said at least one media file” in step [b] has its antecedent basis in step [a], as requiring the argued sequence. (App. Br. 9, 15-17.) Appellants argue that for the quality of service options to “correspond” to a media file, the media file must be selected before the quality of service options are displayed. (App. Br. 9.) Regarding the relationship between steps [b] and [c] and step [d], Appellants contend that

the overall context of the claim 1 requires that steps [b] and [c] must precede step [d]. (App. Br. 17-18.)

Giving the claim its broadest reasonable meaning consistent with the Specification, *see Morris* at 1054, we find, as is implicit in the Examiner's findings, that "corresponding" merely requires that quality of service options appropriate to the media file to be transferred be displayed and available for selection at some time before or during file transfer. Furthermore, in the overall context of the claim, claim 1 merely requires that quality of service options appropriate to the media file to be transferred be displayed and available for selection at some time when a selection would have some effect on a transfer. Accordingly, we find that there is nothing in the claim language that requires, as a matter of logic or grammar, that step [b] must be performed after step [a] or before step [d] or that steps [b] or [c] must be performed before step [d]. *See Altiris* at 1370. Appellants have not pointed to, nor have we found, any provision in the Specification that would require a different result. *Ibid.* Therefore, we find no error in the Examiner's claim construction. Appellants' arguments for the absence of the claimed steps from the disclosures of Nakatsuyama and Radford rest on a claim construction which we find unsupported by the breadth of the appealed claim. Accordingly, we find no error in the Examiner's findings and conclusions regarding the applicability of the cited prior art references to claim 1. We adopt the Examiner's findings and conclusions as our own and find that the Examiner did not err in concluding that claim 1 is anticipated by Nakatsuyama and also by Radford.

CONCLUSION

On the record before us, because we find Appellants argued claim construction is incorrect, we conclude that the Examiner did not err in rejecting claim 1, as well as claims 2-31 not separately argued, as anticipated by Nakatsuyama and Radford.

ORDER

The decision of the Examiner to reject claims 1-31 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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